

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

Appellants: Tevis et al.)	Examiner: Elena T. Lightfoot
)	
Serial Number: 10/528,220)	Group Art Unit: 1792
)	
Filed: March 18, 2005)	Customer Number: 22827
)	
Confirmation No.: 6257)	Deposit Account: 04-1403
)	
Title: "Methods for Applying Coating Compositions to an Article and Articles Produced Thereof")	Docket Number: SGI-0084-PCT-US
)	

1. ☐ **NOTICE OF APPEAL:** Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals and interferences from the last decision of the Examiner.
2. ☐ **PRE-APPEAL BRIEF REQUEST FOR REVIEW:** Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated on the attached sheet(s) [No more than five (5) pages may be provided.]
3. ☒ **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy).
4. ☐ An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within two months after Examiner's Answer).
5. ☐ Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
6. ☐ "Small entity" verified statement filed: [] herewith [] previously.

7. **FEE CALCULATION:**

	Fees
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PETITION is hereby made to extend the original due date of June 2, 2010, hereby made for an extension to cover the date this response is filed for which the requisite fee is enclosed (1 month \$130; 2 months \$490; 3 months \$1,110; 4 months \$1,730, 5 months \$2,350) \$ 130.00

SUBTOTAL: \$ 670.00

Less any previous extension fee paid since above original due date. - \$ 0.00

Less any previous fee paid for prior Notice of Appeal since Board did not render a decision on the merits. MPEP § 1204.01 - \$ 0.00

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Board did not render a decision on the merits. MPEP § 1204.01 - \$ 0.00

SUBTOTAL: \$ 670.00

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TOTAL FEE ENCLOSED: \$ 670.00

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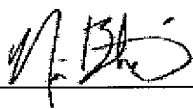
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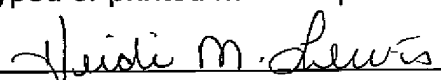
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Heidi M. Lewis

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(Signature of person transmitting documents)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

Application of:	Tevis et al.)	Examiner:	Elena T. Lightfoot
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Serial Number:	10/528,220)	Group Art Unit:	1792
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Filed:	March 18, 2005)	Customer Number:	22827
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Confirmation No.:	6257)	Deposit Account:	04-1403
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Title:	"Methods for Applying Coating Compositions to an Article and Articles Produced Thereof")	Docket Number:	SGI-0084-PCT-US
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BRIEF ON APPEAL

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit the following brief on appeal in accordance with 37 C.F.R. §
41.37:

1. REAL PARTY IN INTEREST

The real party in interest in this matter is the assignee of record, Scientific
Games Royalty Corporation.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellants or the
Appellants' legal representative which will directly affect or be directly affected by or
have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS

Claims 24-37 and 39-40 are pending in the application, including independent
claims 24, 25 and 40. Claims 1-23 and 38 were previously cancelled and claim 24 was

previously withdrawn from consideration. All of the claims are attached hereto in the Claims Appendix.

In the Final Office Action of December 2, 2009, claims 25-37 and 39-40 were finally rejected under 35 U.S.C. § 103(a). The rejection of claims 25-37 and 39-40 is hereby appealed.

4. STATUS OF AMENDMENTS

To the Appellants' knowledge, all amendments have been entered into the record.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 25 is directed to a method for applying an image onto a game card. The method includes:

(a) Applying a first composition comprising a first oligomer comprising an energy-curable oligomer to the outer surface of the game card to produce a first layer, wherein after the application step (a), a first layer comprising the first oligomer is on the outer surface of the game card, and wherein the first layer has an outer surface. See, e.g., page 3, lines 1-5.

(b) Drying the game card produced after step (a). See, e.g., page 3, line 6.

(c) At least partially curing the first composition. See, e.g., page 7, lines 14-20.

(d) Applying a second composition comprising a second oligomer comprising an energy-curable oligomer to the outer surface of the first layer to produce a second layer, wherein after the application step (d), the second layer is on the outer surface of

the first layer, and wherein the second layer has an outer surface. See, e.g., page 3, lines 7-11.

(e) Drying the game card produced after step (d). See, e.g., page 3, line 12.

(f) At least partially curing the second composition. See, e.g., page 7, lines 14-20.

(g) Applying a third composition comprising a third oligomer comprising an energy-curable oligomer to the outer surface of the second layer to produce a third layer, wherein after the application step (g), the third layer is on the outer surface of the second layer. See, e.g., page 3, lines 13-16.

(h) Curing the first oligomer, the second oligomer, and the third oligomer. See, e.g., page 3, line 17.

(i) Applying an ink to the outer surface of the first layer, or the outer surface of the second layer, or to both, so as to form an image. See, e.g., page 8, lines 18-30.

Independent claim 40 is directed to a method for applying a coating composition to a lottery ticket having an outer surface. The method includes:

(a) Applying a first composition comprising a first oligomer comprising an energy-curable, water-based oligomer to the outer surface of the ticket to produce a first layer, wherein after the application step (a), a first layer comprising the first oligomer is on the outer surface of the ticket, and wherein the first layer has an outer surface. See, e.g., page 3, lines 1-5.

(b) Drying the ticket produced after step (a) at a temperature of from 230° F to 390° F in the presence of a large flow of air volume while also partially curing the first oligomer. See, e.g., page 3, line 6; page 7, lines 3-13.

(c) Applying a second composition comprising a second oligomer comprising an energy-curable, water-based oligomer to the outer surface of the first layer to produce a second layer, wherein after the application step (c), the second layer is on the outer surface of the first layer, and wherein the second layer has an outer surface. See, e.g., page 3, lines 7-11.

(d) Drying the ticket produced after step (c) at a temperature of from 230° F to 390° F in the presence of a large flow of air volume while also partially curing the second oligomer. See, e.g., page 3, line 12; page 7, lines 3-13.

(e) Applying an image ink to the outer surface of the second layer to produce an image. See, e.g., page 8, lines 18-30.

(f) Drying the ticket produced after step (e). See, e.g., page 8, lines 18-30.

(g) Applying a third composition comprising a third oligomer comprising energy-curable oligomer over the image and the outer surface of the second layer to produce a third layer. See, e.g., page 3, lines 13-16; page 8, lines 5-30.

(h) Curing the first oligomer, the second oligomer, and the third oligomer with an electron beam, wherein the first oligomer, the second oligomer and/or the third oligomer comprises a polyester acrylate, urethane acrylate, an epoxy acrylate or a combination thereof. See, e.g., page 3, line 17; page 4, lines 8-14; page 8, lines 12-13.

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

In the Final Office Action of December 2, 2009, claims 25-35, 37, 39, and 40 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,899,752 (Sekioka et al.) in view of U.S. Patent 5,698,284 (Kubota et al.), further in

view of JP 07-073511A (Uematsu), and further in view of U.S. Patent 5,698,284 (Danelski).

Claims 25-35 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekioka et al. in view of Kubota et al., further in view of U.S. Patent 6,472,026 (Maag et al.), further in view of Uematsu and further in view of Danelski.

Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of Sekioka et al., Kubota et al., Uematsu and Danelski or over a combination of Sekioka et al., Kubota et al., Maag et al., Uematsu, and Danelski as applied above, and further in view of U.S. Patent 4,303,696 (Brack).

Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of Sekioka et al., Kubota et al., Uematsu and Danelski or over a combination of Sekioka et al., Kubota et al., Maag et al., Uematsu, and Danelski as applied above, and further in view of U.S. Patent 5,795,642 (Ishikawa et al.).

7. ARGUMENT

Appellants respectfully submit that the presently pending claims are patentable over the cited reference.

- I. U.S. Patent No. 6,899,752 to Sekioka et al. does not qualify as prior art against claims 25-37 and 39-40 of the present application under any of the paragraphs of 35 U.S.C. 102.**

The present application properly claims priority to provisional application serial number 60/416,999, filed on October 8, 2002. However, Sekioka et al. was filed on May 16, 2003, or more than 7 months after the priority date of the present application. Thus, Sekioka et al. is not available as prior art under 35 U.S.C. 102 (a), (b), or (e). Furthermore, Sekioka et al. claims priority to PCT/JP01/10065 which published in

Japanese on May 23, 2002. Thus, PCT/JP01/10065 is not available as prior art under 35 U.S.C. 102 (b) or (e) and the Examiner has never provided any information regarding the content of the Japanese publication. As such, it is respectfully submitted that the Examiner's rejections of claims 25-37 and 39-40 is improper and should be reversed.

II. Independent claims 25 and 40 patentably define over Sekioka et al. in any proper combination.

As described above, Appellants believe that Sekioka et al. is not available as prior art and should not be considered. In an abundance of caution, however, Appellants present arguments herewith as to why the presently pending claims patentably define over Sekioka et al.

The present application is directed to methods for applying coating compositions to an article. The claimed methods of the present application provide numerous advantages over prior art techniques. For example, the claimed methods produce game cards with much whiter game play data area. In addition, backside wick test results are much improved and no bleed detecting dye is necessary in the lower blocking layer because of the improved barrier properties. Ticket opacity is also much improved.

A. Independent claims 25 and 40 are patentably distinct over Sekioka et al. in view of U.S. Patent 5,698,284 (Kubota et al.), further in view of JP 07-073511A (Uematsu), and further in view of U.S. Patent 5,698,284 (Danelski).

The presently pending claims require various limitations, including:

1) **applying a first composition** comprising a first oligomer comprising an energy-curable oligomer to the outer surface of the game card to produce a first layer, wherein

after the application step a first layer comprising the first oligomer is on the outer surface of the game card, and wherein the first layer has an outer surface;

2) **applying a second composition** comprising a second oligomer comprising an energy-curable oligomer to the outer surface of the first layer to produce a second layer, wherein after the application step the second layer is on the outer surface of the first layer, and wherein the second layer has an outer surface;

3) **applying an ink** to the outer surface of the first layer, or the outer surface of the second layer, or to both, so as to form an image; and

4) **applying a third composition** comprising a third oligomer comprising an energy-curable oligomer to the outer surface of the second layer to produce a third layer, wherein after the application step the third layer is on the outer surface of the second layer.

As described in the present application, once the image ink has been applied to the outer surface of the first or second layer, a subsequent layer can be applied over the image and can be in contact with the image as well as the outer surface of the first or second layer. See, e.g., page 8, lines 18-30.

By sharp contrast, none of the cited references teach or suggest forming an energy-curable oligomer layer having an outer surface and applying an ink to such outer surface, and applying another energy-curable oligomer layer over the outer surface. For instance, Sekioka et al. describes an ink composition that is formed, in part, with a curing resin composition. Col. 2, lines 61-65; Col. 8, lines 5-10. The Final Office Action describes that Sekioka et al. discloses a method in which a "UV curable ink resin composition" is applied to a plastic substrate and then another "UV curable resin" is

applied to the ink. The UV curable ink resin layer differs from the presently pending claims, which require forming an energy-curable oligomer layer, and then applying an ink to the outer surface of such layer. Importantly, the ink composition of Sekioka et al. is not applied to the outer surface of an energy-curable oligomer layer, as required by the pending claims, but is instead applied directly to a plastic substrate. In other words, there is absolutely no teaching or suggestion in Sekioka et al. of an energy-curable oligomer layer being formed, after which an ink is applied to the surface of such layer, after which *another* energy-curable layer is formed and applied to the surface of such layer. Kubota et al., Uematsu, and Danelski fail to remedy this deficiency. As such, it is respectfully submitted that the pending claims patentably define over the cited references.

Indeed, even if the other references remedied the deficiencies of Sekioka et al. (which Appellants do not believe to be the case), Sekioka et al. teaches away from the limitations of the pending claims. The purpose of the protective film of Sekioka et al. is to *prevent* anything from concealing the ink composition underneath. Such a film teaches away from the presently pending claims in that the claims require applying an ink to an outer surface of the claimed first or second layer.

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). Furthermore, a reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. §2141.02.

The description of Sekioka et al. expressly teaches away from applying an ink to an outer surface of a first or second layer in that an ink composition is already present underneath the protective film and used to form a latent image. The description makes it clear that the protective film is designed to prevent obstructions from blocking the covered ink composition. As such, it is respectfully submitted that the claims patentably define over Sekioka et al. in any proper combination.

For example, in a previous Office Action it was stated that because “Danielski teaches that game tickets or cards are generally provided with visible image by lithographically printing with UV curable ink...in addition to concealed images...it would have been obvious to one of ordinary skill in the art at the time the invention was made to have printed a visible image on a second layer.” Page 11, July 29, 2009 Office Action. However, as stated above, Sekioka et al. teaches away from applying an ink to the outer surface of the product described therein. Furthermore, Danielski only describes printing onto a removable film to expose a concealed image. As described in Danielski, “[r]emoval of the film from the inked surface portion also removes the ink in one of the selected patterns to reveal a desired pattern of deinked outer surface and thereby render visible the previously concealed message.” In other words, the ink is only present on the outer surface because the outer surface is removable to reveal a concealed message. Such a configuration is the complete opposite of the configuration described in Sekioka et al.

In response, the Final Office Action asserts that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have printed a visible image with UV curable ink on a second layer of three-layer protective film of

Sekioka et al. in view of Kubota et al. such that the visible [image] would be protected with a protective film.” Page 5, December 2, 2009 Final Office Action. However, it is respectfully submitted that none of the cited references teach or suggest applying an ink to the outer surface of an energy-curable oligomer layer, as required by the pending claims. As such, it is respectfully submitted that the presently pending claims patentably define over the cited references.

B. Independent claim 25 is patentably distinct over Sekioka et al. in view of Kubota et al., further in view of U.S. Patent 6,472,026 (Maag et al.), further in view of Uematsu and further in view of Danelski.

For at least the reasons above, and because Maag et al. fails to remedy the deficiencies noted above, it is respectfully submitted that the presently pending claims also patentably define over Sekioka et al. in view of Kubota et al., further in view of Maag et al., further in view of Uematsu, and further in view of Danelski.

C. Dependent claims 26-37 and 39 patentably define over any proper combination of Sekioka et al., Kubota et al., Uematsu and Danelski, Maag et al., U.S. Patent 4,303,696 (Brack), and U.S. Patent 5,795,642 (Ishikawa et al.).

Dependent claims 26-37 and 39 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over a variety of references. However, for at least the reasons discussed above with respect to independent claims 25 and 40, it is respectfully submitted that the presently pending dependent claims patentably define over the cited references, either alone or in any proper combination.

For instance, dependent claims 30 and 31 require the first oligomer and second oligomer to be present from 10% to 40% by weight of the first composition and second composition and the third oligomer to be present from 15% to 50% by weight of the third

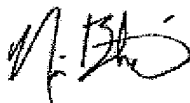
composition, respectively. There is absolutely no teaching provided for such ranges and it is clear from the disclosure that such ranges are important to achieving the inventive characteristics of the claimed products.

Similarly, dependent claim 39 requires a water-based ink. As discussed above, Sekioka et al. plainly states that the protective film described therein "must be hard and tough, water-resistant, fouling resistant and scratch resistant, and capable of...permitting reliable discrimination of the latent image." Col. 8, lines 5-10 (emphasis added). As such, there can be no question that dependent claim 39 patentably defines over Sekioka et al. in any proper combination since the film of Sekioka et al. would be resistant to a water-based ink.

For the reasons stated above, it is Appellants' position that the Examiner's rejection of claims has been shown to be untenable and should be **reversed** by the Board. Please charge any additional fees required by this Appeal Brief to Deposit Account No. 04-1403.

Respectfully submitted,

DORITY & MANNING, P.A.



Neil M. Batavia
Registration No. 54,599

July 1, 2010

Date

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9. CLAIMS APPENDIX

1-23. (Canceled).

24. (Withdrawn) An article having an outer surface and at least three layers of coating, comprising: a first layer created from the application of a first composition of a first oligomer of an energy-curable oligomer, the first composition being dried upon the outer surface of the article to produce the first layer, and the first layer having an outer surface; a second layer created from the application of a second composition of a second oligomer of an energy-curable oligomer, the second composition being dried upon the outer surface of the first layer to produce the second layer, and the second layer having an outer surface; and a third layer created from the application of a third composition of a third oligomer of an energy-curable oligomer, the third composition applied to the outer surface of the second layer to produce a third layer, and the applied third layer being cured such that the first oligomer, the second oligomer, and the third oligomer are cured.

25. (Rejected) A method for applying an image onto a game card, the method comprising the steps of:

- (a) applying a first composition comprising a first oligomer comprising an energy-curable oligomer to the outer surface of the game card to produce a first layer, wherein after the application step (a), a first layer comprising the first oligomer is on the outer surface of the game card, and wherein the first layer has an outer surface;
- (b) drying the game card produced after step (a);
- (c) at least partially curing the first composition;
- (d) applying a second composition comprising a second oligomer comprising an energy-curable oligomer to the outer surface of the first layer to produce a second layer, wherein after the application step (d), the second layer is on the outer surface of the first layer, and wherein the second layer has an outer surface;
- (e) drying the game card produced after step (d);
- (f) at least partially curing the second composition;

(g) applying a third composition comprising a third oligomer comprising an energy-curable oligomer to the outer surface of the second layer to produce a third layer, wherein after the application step (g), the third layer is on the outer surface of the second layer;

(h) curing the first oligomer, the second oligomer, and the third oligomer; and

(i) applying an ink to the outer surface of the first layer, or the outer surface of the second layer, or to both, so as to form an image.

26. (Rejected) The method of claim 25, wherein the composition in steps (a), (d) and (g) is applied by flexography, roto gravure, screen printing, offset, letter press or roll coater.

27. (Rejected) The method of claim 25, wherein the first oligomer and second oligomer are water based.

28. (Rejected) The method of claim 25, wherein the first oligomer, the second oligomer and the third oligomer comprises an epoxy acrylate, a urethane acrylate, a polyester acrylate, an acrylated acrylic, a cycloaliphatic diepoxide or a combination thereof.

29. (Rejected) The method of claim 25, wherein the first oligomer, the second oligomer and the third oligomer comprises (1) a polyester or urethane having an acrylate group or (2) a cycloaliphatic diepoxide.

30. (Rejected) The method of claim 25, wherein the first oligomer and second oligomer is from 10% to 40% by weight of the first composition and second composition.

31. (Rejected) The method of claim 25, wherein the third oligomer is from 15% to 50% by weight of the third composition.

32. (Rejected) The method of claim 25, wherein the third oligomer is not water-based.

33. (Rejected) The method of claim 25, wherein the first composition comprises water, a surfactant, a thickener, a pigment or dye, and a first oligomer comprising a water-based, energy-curable oligomer.
34. (Rejected) The method of claim 25, wherein the second composition comprises water, a surfactant, a thickener, an absorbent, a pigment or dye, and a second oligomer comprising a water-based, energy-curable oligomer.
35. (Rejected) The method of claim 25, wherein the third composition comprises a surfactant, a slip additive, a release additive, a wax and a third oligomer comprising an energy-curable oligomer.
36. (Rejected) The method of claim 25, wherein the drying steps (b) and (e) are performed by a dryer at a temperature of from 230°F to 390°F in the presence of a large flow of air volume.
37. (Rejected) The method of claim 25, wherein the curing step (f) is performed by exposing the game card produced after step (g) to an electron beam or UV lamp.
38. (Cancelled).
39. (Rejected) The method of claim 25, wherein the ink is water-based.
40. (Rejected) A method for applying a coating composition to a lottery ticket having an outer surface, comprising
- (a) applying a first composition comprising a first oligomer comprising an energy-curable, water-based oligomer to the outer surface of the ticket to produce a first layer, wherein after the application step (a), a first layer comprising the first oligomer is on the outer surface of the ticket, and wherein the first layer has an outer surface;
 - (b) drying the ticket produced after step (a) at a temperature of from 230 ° F to 390 ° F in the presence of a large flow of air volume while also partially curing the first oligomer;
 - (c) applying a second composition comprising a second oligomer comprising an energy-curable, water-based oligomer to the outer surface of the first layer to produce a

second layer, wherein after the application step (c), the second layer is on the outer surface of the first layer, and wherein the second layer has an outer surface;

(d) drying the ticket produced after step (c) at a temperature of from 230° F to 390° F in the presence of a large flow of air volume while also partially curing the second oligomer;

(e) applying an image ink to the outer surface of the second layer to produce an image;

(f) drying the ticket produced after step (e);

(g) applying a third composition comprising a third oligomer comprising energy-curable oligomer over the image and the outer surface of the second layer to produce a third layer; and

(h) curing the first oligomer, the second oligomer, and the third oligomer with an electron beam, wherein the first oligomer, the second oligomer and/or the third oligomer comprises a polyester acrylate, urethane acrylate, an epoxy acrylate or a combination thereof.

10. **EVIDENCE APPENDIX**

None

11. **RELATED PROCEEDINGS APPENDIX**

None